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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/812,614	03/29/2004	David Django Dexter	157972-0011	3198
68368 7590 05/29/2007 BARCELO & HARRISON, LLP 22091 WOOD ISLAND LANE HUNTINGTON BEACH, CA 92646			EXAMINER SAETHER, FLEMMING	
			ART UNIT 3677	PAPER NUMBER
			MAIL DATE 05/29/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/812,614	Applicant(s) DEXTER ET AL.	
	Examiner Flemming Saether	Art Unit 3677	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 March 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

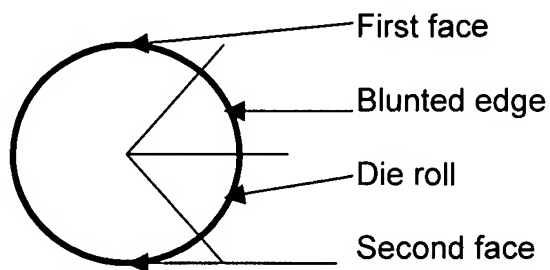
Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2 and 4 are rejected under 35 U.S.C. 102(b) as being anticipated by Seibert (US 3,045,265). Seibert discloses a snap ring (30) with an interior contour having a first and second face with an edge bordering each face. Since the ring is round, the edges are also round where one edge is read as the blunted edge while the other edge is read as the die roll (see diagram below) and round ring also provide a the radius of curvature 50% of the thickness. The rounded edge is capable of contacting an object during installation.



Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3, 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rohr (US 5,383,938) in view of Millheiser (US 4,343,581). Rohr discloses snap ring (30) with an interior contour having a first and second face with an edge bordering each face. The edge bordering the second end face is shown as blunted in the form of a bevel (36) having an angle between 10 and 40 degrees and a thickness of 60% to 85% that of the ring (see Figs. 4 and 5). Rohr does not disclose a die roll at the first edge. Millheiser discloses a snap ring having a bevel at both its first and second edges (Fig. 4) and teaches its superiority to only having a single bevel. Therefore, at the time the invention was made, it would have been obvious for one of ordinary skill in the art to provide the snap ring of Rohr with a second bevel in view of the teaching of equivalence in Millheiser. The bevel is capable of contacting an object during installation.

Claims 7, 8 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Toh (US 6,856,485) in view of Seibert. Toh discloses an actuator arm comprising an actuator (29), an actuator pivot bearing (31) and a snap ring (32) but, does not disclose the specifics of the snap ring as claimed. Seibert discloses a snap ring (30) as discussed above. At the time the invention was made, it would have been obvious for one of ordinary skill in the art to form the ring of Toh as shown in Seibert because the ring as in Seibert would be easier to manufacture since it is simply formed from a wire stock.

Claims 7, 9, 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Toh (US 6,856,485) in view of Rohr and Millheiser. Toh discloses an actuator arm comprising an actuator (29), an actuator pivot bearing (31) and a snap ring (32) but, does not disclose the specifics of the snap ring a claimed. Modified Rohr discloses a snap ring as discussed above. At the time the invention was made, it would have been obvious for one of ordinary skill in the art to form the ring of Toh as shown in modified in order to improve its connection with the actuator pivot bearing since the bevel allows for an improved connection as discussed in Rohr.

Response to Arguments

Initially, it should be recognized that the rejection remains unchanged.

Applicant argues that Seibert does not disclose the claimed die roll. In response, the examiner disagrees because the die roll as claimed is disclosed in Seibert as discussed in the above rejection. There is nothing in the claims which would prevent Seibert from reading on the die roll.

Applicant next argues the combination of Rohr and Millheiser in that there would be no motivation for the combination and the reference in fact teach away from one another. Applicant initially argues that a second chamfer would be incompatible with Rohr but fails to provide any support for the conclusion. In response, since the applicant seems to indicate that the combination would leave the device inoperative,

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applicant is simply reminded that the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

Applicant next argues Millheiser in that in Millheiser does not disclose the equivalence of the single and double bevel designs but instead teaches the double bevel design as an improvement over the single bevel. In response, the examiner agrees but, it is not understood how this would lead one away from the combination. To the contrary, the teaching that the double bevel design is an improvement would have provided motivation to the skilled artisan to improve the single bevel design of Rohr in a manner similar to Millheiser to have double bevel to achieve the same objectives as noted in Millheiser.

Applicant next argues that combination of Rohr and Millheiser would not have been motivated because the intended purpose of the bevel in Rohr and Millheiser are different. In Rohr the bevel is intended to facilitate easy installation by having a mismatching bevel, whereas in Millheiser the bevel is intended to be matching to eliminate end play. In response, the examiner disagrees because in Rohr, the mismatch bevel with respect to an end of an object ("liner") for the ease of installation

onto the object while in Millheiser the matching bevel is with the groove in an object. In other words, the mismatch referred to in Rohr and the match referred to in Millheiser are in reference to difference portions of the connection of the ring and object. Therefore, the combination of Rohr and Millheiser would provide for the optimal configuration of ease on installation of the object and elimination of end play once in the groove irrespective of the direction in which the ring is installed.

Applicant next argues the combination of Toh and Seibert because there is no disclosure in Seibert that it is made simply from a piece of wire and it would easy to manufacture. In response, the examiner disagrees because the Seibert shows the cross section of the ring (either 3 or 130) to have a constant cross-section and it is well known to economically form such articles by extrusion into a elongated stock which can be further manufactured into a ring shape by cutting it to length and rolling it in to shape which would be much more economical than the complex shape shown in Toh. Indeed, the motivation to combine need not be found in the in the references themselves but, may be found in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). Applicant further that if the ring of Seibert were in fact from wire stock then it would not include the claimed "roll die". In response, as noted above, the examiner maintains Seibert does disclose the "roll die".

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Applicant next argues the combination of Toh, Rohr and Millheiser where additionally, applicant argues that Rohr does not teach an "improved connection" to motivate the combination. In response, the examiner disagrees because the improved connection is provided by the beveled surfaces which facilitates ease of assembly as discussed above.

Applicant concludes that none of the references taken alone or even in combination discloses the "roll die". In response, the examiner still disagrees because, as noted above, there is nothing in the claims which would preclude the examiners reading of "roll die" as described in the above rejections. Furthermore, applicant is reminded that while the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

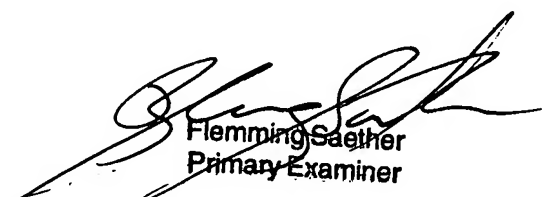
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Flemming Saether whose telephone number is 571-272-7071. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Judy Swann can be reached on 571-272-7075. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Flemming Saether
Primary Examiner